

Application No. 09/407,751

RXSID 1000-1

**REMARKS**

In the Official Action mailed 23 June 2004, the Examiner objected to the drawings because they are informal. Formal drawings are submitted herewith with a separate transmittal to the Official Draftsperson as required by the Examiner.

The Examiner objected to the specification. The Examiner considered claims 1-132 and rejected claims 1-132. Claims 11-15, 24-27, 32-35, 38 and 76 are rejected under 35 U.S.C. §112, second paragraph; claims 1, 5-9, 11-18, 22-32, 36-40, 42, 47-50, 54-63, 65-67, 69-74, 76-80, 84-97, 99-116 and 120-131 are rejected under 35 U.S.C. §102(b); claims 1, 33, 34, 39, 43, 74, 75 and 111 are rejected under 35 U.S.C. §102(c); claims 2-4, 10, 44-46, 68, 98 and 132 are rejected under 35 U.S.C. §103(a); claims 19-21, 51-53, 81-83 and 117-119 are rejected under 35 U.S.C. §103(a); claims 35 and 41 are rejected under 35 U.S.C. §103(a); claim 64 is rejected under 35 U.S.C. §103(a).

Applicant has canceled claims 1-38, 42, 43, 49, 56 and 74-132, without prejudice, and amended claims 39-41, 47, 48, 50-55, 57-59, 61-64 and 69-73. Claims 39-41, 44-48, 50-55 and 57-73 remain pending.

Each of the Examiner's objections and rejections is respectfully traversed below.

**Objection to the specification**

The Examiner has objected to the specification, page 17, line 3, for making reference to a "second screen 17" in Fig. 17. Applicant has amended the specification to correct the mistake.

**Rejection of Claims 11-15, 24-27, 32-35, 38 and 76 under 35 U.S.C. §112, second paragraph**

Claims 11-15, 24-27, 32-35, 38 and 76 are rejected under 35 U.S.C. §112, second paragraph. The offending claims have been canceled without prejudice.

**Rejection of Claims 1, 5-9, 11-18, 22-32, 36-40, 42, 47-50, 54-63, 65-67, 69-74, 76-80, 84-97, 99-116 and 120-131 under 35 U.S.C. §102(b)**

Claims 1, 5-9, 11-18, 22-32, 36-40, 42, 47-50, 54-63, 65-67, 69-74, 76-80, 84-97, 99-116 and 120-131 are rejected under 35 U.S.C. §102(b) as being anticipated by Terry et al. (US 5,388,185). In light of the cancellations mentioned above, claims 39, 40, 42, 47-50, 54-63, 65-67, 69-73, as amended, are still pending. Claim 39 is the sole independent claim.

Application No. 09/407,751

RXSD 1000-1

Applicant has amended claim 39 in light of the Examiner's broad interpretation, to distinguish over Terry et al. Support for the amendment is found in Fig. 9 of the present application, and the supporting description. The inventors on the present application have enabled extending use of hearing profiles beyond the telephone, to mass audience audio products never contemplated in the prior art, by providing for presentation of a catalog of audio data products using a graphical user interface to a user and delivering customized products.

Claim 39, as amended, distinguishes over Terry et al., for example, because Terry et al. does not describe requesting an audio data product from a catalog using a graphical user interface. Terry et al. describes a system in which a single product, a telephone call, is processed according to the hearing profile of a customer. There is no discussion in Terry et al. that suggests its application beyond the telephone, to a catalog of audio data products potentially having variant formats, and played by variant devices.

Although original claim 39 does not include a "graphical user interface," in paragraph 19 of the Office Action, apparently referring to original claims 48 and 56, which include a "network interface," the Examiner relies on the DTMF interface on a telephone as described by Terry et al. to teach a graphical user interface. Applicant respectfully disagrees. A telephone touch pad is not a graphical user interface, according to the well-accepted definition of a graphical user interface in the industry, and to the use of the phrase in the present application.

Furthermore, the DTMF of Terry et al. is used only for inputting hearing profile data, and dialing phone numbers. Such an interface would not be useful for selecting audio data products from a catalog presented by a graphical user interface, as recited in the claims as amended.

Terry et al. therefore does not anticipate claim 39 as amended, nor any of the claims depending therefrom.

Accordingly, reconsideration of the rejection of claims 39, 40, 42, 47-50, 54-63, 65-67, 69-73 is respectfully requested, in view of the amendments.

Rejection of Claims 1, 33, 34, 39, 43, 74, 75 and 111 under 35 U.S.C. §102(e)

Claims 1, 33, 34, 39, 43, 74, 75 and 111 are rejected under 35 U.S.C. §102(e) as being anticipated by Knappe et al. (US 6,061,431). In light of the cancellations mentioned above, claims 39 and 43, as amended, are still pending. Claim 39 is the sole independent claim.

Application No. 09/407,751

RXSD 1000-1

Applicant has amended claim 39 in light of the Examiner's broad interpretation, to distinguish over Knappe et al. Support for the amendment is found in Fig. 9 of the present application, and the supporting description.

Claim 39, as amended, distinguishes over Knappe et al., for the same reasons as it distinguishes over Terry et al., and the discussion of Terry et al. is incorporated by reference here.

Knappe et al. therefore does not anticipate claim 39 as amended, nor any of the claims depending therefrom.

Accordingly, reconsideration of the rejection of claims 39 and 43 is respectfully requested, in view of the amendments.

Rejection of Claims 2-4, 10, 44-46, 68, 98 and 132 under 35 U.S.C. §103(a)

Claims 2-4, 10, 44-46, 68, 98 and 132 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knappe et al., in view of Kopke et al. (US 4,471,171). In light of the cancellations mentioned above, claims 44-46 and 68, as amended, are still pending. All of the pending claims depend from Claim 39.

Applicant submits that claims 44-46 and 68 are patentable for at least the same reasons as claim 39.

Accordingly, reconsideration of the rejection of claims 44-46 and 68 is respectfully requested, in view of the amendments.

Rejection of Claims 19-21, 51-53, 81-83 and 117-119 under 35 U.S.C. §103(a)

Claims 19-21, 51-53, 81-83 and 117-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terry et al. (US 5,388,185). In light of the cancellations mentioned above, claims 51-53, as amended, are still pending. All of the pending claims depend from Claim 39.

Applicant submits that claims 51-53, as amended, call for the catalog of claim 39 to comprise pre-recorded or live music, or pre-recorded voice tracks. Such claims are patentable for at least the same reasons as claim 39. Furthermore, Terry is limited to telephone systems. Claims 51-53 relate to audio products that are prerecorded or otherwise prepared usually for mass audiences. No reference has ever suggested customizing audio products selected from a catalog using a graphical user interface, such as the type of audio stated in these claims, for delivery to individuals using their hearing profiles.

Application No. 09/407,751

RXSD 1000-1

The Examiner discusses various audio material, that can be played in a telephone call by automated PBX systems that add audio tracks to phone calls during "on hold" conditions, and suggests that to do so would meet claims 51-53. These examples provided by the Examiner do not support the idea that Terry et al. might be extended to suggest claim 39 as amended to include presentation of a catalog of audio data products using a graphical user interface. None of the background audio tracks inserted by the PBX systems, that the Examiner describes, is selected by the customer at all.

Accordingly, reconsideration of the rejection of claims 51-53 is respectfully requested, in view of the amendments.

Rejection of Claims 35 and 41 under 35 U.S.C. §103(a)

Claims 35 and 41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Terry et al. (US 5,388,185) in view of Ohuchi et al. (US 5,526,423). In light of the cancellations mentioned above, claim 41, as amended, is still pending. Claim 41 depends from Claim 39.

Applicant submits that claim 41 is patentable for at least the same reasons as claim 39. Furthermore, claim 41 is amended to recite that the machine readable medium is portable, and therefore, suitable for delivery to a customer. No reference cited by the Examiner suggests storing customized audio products on portable machine readable media, as recited in the claims. This feature of the invention is a manifestation as well of the inventors' vision of providing customized mass audience audio to individuals, according to their own hearing profiles.

Accordingly, reconsideration of the rejection of claim 41 is respectfully requested, in view of the amendments.

Rejection of Claim 64 under 35 U.S.C. §103(a)

Claim 64 is rejected under 35 U.S.C. §103(a) as being unpatentable over Terry et al. (US 5,388,185) in view of Zanco et al. (US 5,630,159). Claim 64 depends from claim 39 as amended, and is patentable for at least the same reasons.

Accordingly, reconsideration of the rejection of claim 64 is respectfully requested, in view of the amendments.

Application No. 09/407,751

RXSD 1000-1

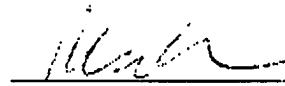
CONCLUSION

It is submitted that this application is now in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (RXSD 1000-1).

Respectfully submitted,

Dated: 17 December 2004



Mark A. Haynes, Reg. No. 30,846

HAYNES BEFFEL & WOLFELD LLP

P.O. Box 366

Half Moon Bay, CA 94019

(650) 712-0340 phone

(650) 712-0263 fax